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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,130	08/08/2006	Richard Twomey	DEP5008	6010
27777	7590	05/27/2009	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			SCHILLINGER, ANN M	
ART UNIT		PAPER NUMBER		
3774				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,130	<b>Applicant(s)</b> TWOMEY ET AL.
	<b>Examiner</b> ANN SCHILLINGER	<b>Art Unit</b> 3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 March 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3.5 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3.5 and 8-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, 12, 13, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lahille et al. (US Pat. No. 5,554,191) in view of Lange (US Pat. No. 6,123,706). Lahille teaches the following of the claimed invention: a sleeve (3) having an outer surface (311, 321), whose inner surfaces define an internal cavity whose diameter decreases from a distal end to a proximal end (Figs. 6-7), which communicates with an opening (342) formed in the outer surface, the sleeve being formed from a deformable material (Fig. 15; col. 4, lines 45-50; col. 7, lines 29-45); an expander (36) comprising a shaft having a distal and a traverse portion (37) where the shaft extends through the opening and moves to cause the sleeve to expand (col. 7, lines 46-54). The sleeve has an end wall (33), which is formed as single body with the wall of the sleeve, an indent (341), and features (313, 323) to promote engagement with a bone surface. Lahille et al. further discloses an insertion instrument (4).

Lahille et al. teaches the use of a washer (363), however, the washer does not have the claimed radial slots. Lange teaches a stabilization device with a star shaped washer (52) in col. 3, line 59 through col. 4, line 6 for the purpose of securely locking the stabilizing device its proper position. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to replace the washer of Lahille et al. with the washer of Lange which has radial slots in order to lock the device in its proper position.

Please note that the claim language such as “configured to/for” and “adapted to/for” is functional language. In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lahille et al. in view of Lange, further in view of Spierings (US Pat. No. 6,669,733). Lahille, as modified by Lange, discloses the invention substantially as claimed, however, they do not disclose an expander where the shaft can break. Spierings teaches an expander where the shaft can break in col. 4, lines 25-40 for the purpose of causing the maximum compression force on the body to obtain a strong fixation of the prosthesis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an expander where the shaft can break in order to cause the maximum compression force on the body to obtain a strong fixation of the prosthesis.

Claims 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lahille et al. in view of Lange, as shown in claims 1, further in view of Evans et al. (US Pat. No. 7,156,880). Lahille, as modified by Lange, discloses the invention substantially as claimed, however, they do not disclose using resorbable materials. Evans et al. teaches using resorbable materials in col. 25, lines 33-61 for the purpose of leaving a larger effective porosity. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use resorbable materials in order to leave a larger effective porosity.

Claims 10, 11, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lahille et al. in view of Lange. Lahille et al., as modified by Lange, discloses the invention substantially as claimed, however, they do not disclose the angles of expansion and the specific material hardness measurements disclosed by the Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these values, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5, and 8-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./  
Examiner, Art Unit 3774

/DAVID ISABELLA/  
Supervisory Patent Examiner, Art Unit 3774